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EXAMINER

CALDWELL, ANDREW T

ART UNIT PAPER NUMBER

2151

DATE MAILED: 01/06/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/189,410

Applicant(s)

KURIKI ET AL.

Examiner

Andrew Caldwell

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 15, 22 and 26 is/are allowed.
- 6) ☐ Claim(s) 1, 2, 4-6, 8, 12-14, 16-21, 23-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) 7, 9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Remarks**

Claims 1-9 and 11-30 are pending.

**Specification**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: See the rejection under 35 U.S.C. 112, first paragraph, below.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because it commensurate with the invention as currently claimed. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16-17 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 16-17 and 30 require that the receivers' responses are capable of being made in an arbitrary order with respect to each other. The specification does not describe this feature.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

1 were made absent any evidence to the contrary. Applicant is advised of the obligation  
2 under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was  
3 not commonly owned at the time a later invention was made in order for the examiner to  
4 consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)  
5 prior art under 35 U.S.C. 103(a).

6  
7 Claims 1-2, 4-6, 8, 12, 16-21, 23-25, and 27-30 rejected under 35 U.S.C. 103(a)  
8 as being unpatentable over Lytle et al., U.S. Pat. No 6,549,950, in view of Trenbeath et  
9 al., U.S. Patent No. 6,324,487, and Harp, Jr., U.S. Patent No. 5,585,612. Claims 28-29  
10 will be discussed first.

11  
12 Regarding claim 28, Lytle teaches the invention substantially as claimed by  
13 disclosing a method comprising based on interactive input generated by recipients of an  
14 email message when viewing the email message (Fig. 31 voting buttons in received  
15 email message as interactive input; col. 32 line 6 to col. 39 line 13), storing states of the  
16 recipients, where a stored state indicates a degree to which a recipient has completed  
17 an activity discussed in the email message received by the recipients (Fig. 36 modified  
18 sent message storing list of voting responses; col. 32 line 6 to col. 39 line 13), and  
19 where the interactive input is inputted using interactive content displayed with the email  
20 message (Fig. 31 voting buttons).

21 Lytle does not explicitly teach allowing the recipients of the email message to  
22 view a list of the stored states of the recipients of the email message nor the allowing

1 the recipients to each display the stored states responsive to the email message being  
2 selected from a list comprising email messages sent to and received by the respective  
3 recipient. In particular, Lytle teaches that the sent mail message is either stored in the  
4 sender's sent mail folder or some *other* storage location specified by the sender (col. 35  
5 lines 40-49).

6 Trenbeath on the other hand teaches a publish/subscribe system incorporated in  
7 Microsoft Outlook (col. 6 line 62 to col. 7 line 7) allowing multiple computers to share  
8 data objects such as email messages (col. 6 lines 48-55). Trenbeath teaches that  
9 subscribed objects are distributed out to the subscription clients so that replicated  
10 copies exist at the subscription clients (col. 7 lines 1-5 where the meaning of replication  
11 is considered in view of col. 1 lines 55-63). Replicated subscribed objects are sent to  
12 and received by the respective recipient.

13 It would have been obvious to one of ordinary skill in the art at the time the  
14 invention was made to combine Trenbeath's teachings regarding the publish and  
15 subscribe system with the system of Lytle by (1) having Lytle's sender store the sent  
16 email message containing the voting instructions in a publication folder and (2) having  
17 all of Lytle's receivers subscribe to the folder. In the resulting system, the recipients  
18 would be able to open their subscription folder containing the replicated object, click on  
19 the subscribed copy of the sent message, and view the updated version of the sent  
20 email message including the voting results. Such a system renders the subject matter  
21 of claim 28 obvious. This combination would have been obvious to one of ordinary skill  
22 in the art at the time the invention was made because it would implement Harp's "oral

election" where each individual is aware of all others' votes (col. 1 lines 18-24) and because both patents describe different features of the same product, Microsoft Outlook.

Regarding claim 29, Lytle teaches a method wherein the state of the activity reflects a recipient's determination that the recipient has completed the activity (col. 32 line 6 to col. 39 line 13 – user determines which restaurant and votes, with voting as completion of the activity).

Regarding claim 1, it is an apparatus claim directed to the same invention as claim 28. Given the correspondence between an email message of claim 28 and the interpersonal message of claim 1, it should be readily apparent why the reasons for rejection of claim 28 apply equally to claim 1.

Regarding claim 2, Lytle teaches an apparatus wherein:

The sender comprises a manager managing the business activity, the receivers comprise respective staff, the interpersonal message is a message inquiring about progress of the staff concerning the business activity, and the manager receives the response messages from the staff, where the responses include completion information indicating whether the business activity has been completed (Fig. 36 TO: MY Department showing manager and staff; with Fig. 36 elem. 3610 individual's vote as completion information);

The preparation unit prepares the receiver state list containing, in the mutually associated manner, the names of the plurality of receivers and the states of each of the respective receivers to indicate, based on completion

1 information in the responses, whether the business activity has been completed  
2 (col. 32 line 6 to col. 39 line 13).

3 Regarding claim 4, Lytle teaches an apparatus further comprising:

4 A message preparation unit preparing the interpersonal message to be  
5 sent to the receivers by providing the interpersonal message with a confirmation  
6 button to be used by each of the receivers to inform the sender whether the  
7 assigned business activity has been completed (col. 32 line 6 to col. 39 line 13;  
8 Fig. 36 voting buttons as confirmation button);

9 When the confirmation button is activated by one of the receivers, setting  
10 the information contained in the receiver state list to indicate that the activating  
11 receiver has completed the business activity (col. 32 line 6 to col. 39 line 13).

12 Regarding claim 5, Lytle teaches a system wherein the preparation unit prepares  
13 the receiver state list based on the receivers' names and the completion information  
14 (col. 32 line 6 to col. 39 line 13). The combination of Lytle in view of Trenbeath and Hart  
15 teaches a storage unit storing the content of the interpersonal message, receivers'  
16 names and completion information indicating whether the receivers have viewed the  
17 content of the interpersonal message or whether the receivers have completed  
18 business activities related to a content of the interpersonal message, in an associated  
19 manner (Trenbeath's publication folder as storage unit).

20 Regarding claim 6, Lytle teaches a message processing apparatus further  
21 comprising:



1           An amendment unit amending the contents of a transmitted interpersonal  
2           message stored in the storage unit (col. 32 line 6 to col. 39 line 13); and

3           A recovery unit recovering all the receivers' open information indicating an  
4           open state to a not-opened state when the interpersonal message is amended by  
5           the amending unit (col. 32 line 6 to col. 39 line 13).

6           Regarding claim 8, Lytle teaches a message processing apparatus wherein:

7           The storage unit stores a message type of the interpersonal message (col.  
8           32 line 6 to col. 39 line 13); and

9           The preparation unit prepares the receiver state list according to the  
10          message type, the receivers' names and the completion information (col. 32 line  
11          6 to col. 39 line 13).

12          Regarding claim 12, Lytle teaches a message processing apparatus wherein the  
13          message management unit causes a delay state for a response time limit that is set in  
14          the interpersonal message to be displayed as delay information in a received message  
15          list (col. 32 line 6 to col. 39 line 13).

16          Regarding claims 16-17, they are an apparatus and method claim directed to the  
17          same invention as claim 28. The applicability of the rejection to these claims should be  
18          readily apparent from the explanation above given the correspondence between  
19          interpersonal messages and email messages. As to the limitation that the responses  
20          are capable of being made in an arbitrary order with respect to each other, Lytle  
21          teaches this feature (col. 39 lines 3-13). As to the limitation that the sent message be

1 jointly addressed, Lytle also teaches this feature (Fig. 36 TO: My Department as  
2 group/joint addressing).

3 As to claim 18, it is a method claim directed to the same invention as claim 28.  
4 Given the correspondence between email messages and interpersonal messages, the  
5 reasons for rejection should be apparent from the discussion of claim 28 above.

6 Regarding claim 19, Lytle teaches a method comprising displaying the receiver  
7 state list in a manner associated with the interpersonal message (Fig. 36).

8 Regarding claim 20, Lytle teaches a method teaches a method further  
9 comprising:

10 displaying the receiver state list in a manner associated with the  
11 interpersonal message (Fig. 36);

12 Wherein the receiver stat list includes receivers' names and completion  
13 information indicating whether receivers of the interpersonal message have  
14 viewed the interpersonal message or whether the receivers of the interpersonal  
15 message have completed business activities related to a content of the  
16 interpersonal message (Fig. 36 elems. 3605 and 3610).

17 Regarding claim 21, Lytle teaches a method wherein when a manager managing  
18 the business activity sends the interpersonal message to respective staff inquiring about  
19 progress states concerning the business activity (Fig. 36 My Department showing  
20 manager/sender with recipients as staff), and receives response messages from the  
21 plurality of receivers of the interpersonal message inquiring about respective progress  
22 states concerning the assigned business activities, preparing the receiver stat list

1 containing, in the mutually associated manner, the names of the plurality of receivers  
2 and pieces of completion information based upon which the states of the respective  
3 receivers indicate whether the receivers have completed the business activity (col. 32  
4 line 6 to col. 39 line 13).

5       Regarding claims 23-25, they are computer readable media claims  
6 corresponding to method claims 18 and 20-21. Since they do not teach or define above  
7 the information in the corresponding method claims, they are rejected under the same  
8 basis.

9       Regarding claim 27, it is a computer readable media claim corresponding to  
10 apparatus claim 4. Since it does not teach or define above the information in the  
11 corresponding apparatus claim, it is rejected under the same basis.

12       Regarding claim 30, it is an apparatus claim corresponding to apparatus claim 2  
13 with the additional limitation that the responses of the receivers are capable of being  
14 made in an arbitrary order with respect to each other. As to this limitation, Lytle teaches  
15 this feature (col. 39 lines 3-13).

16  
17       Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
18 Lytle in view of Trenbeath and Harp and further in view of Williams, U.S. Patent No.  
19 5,675,733.

20

1           Regarding claim 13, the combination of Lytle in view of Trenbeath and Harp  
2 teaches the invention substantially as claimed. See the rejection of claim 1 above.  
3 Swenson does not teach the additional limitations of claim 13.

4           Williams on the other hand teaches a workflow system that collects and displays  
5 statistical information regarding each workflow, where the system comprises:

6                 An open ratio obtaining unit obtaining an open ratio of the interpersonal  
7 message from open information indicating an open state of the receiver of the  
8 interpersonal message (Col. 1 line 65 to Col. 2 line 22 indicating types of  
9 notifications; Col. 5 lines 39-47 indicating that the COD embodiment is merely  
10 exemplary of how to implement other notifications, Col. 10 lines 1-22); and

11                A display unit displaying the open ratio of the interpersonal message in a  
12 message list (Col. 11 lines 18-55).

13           It would have been obvious to one of ordinary skill in the art at the time the  
14 invention was made to combine Williams' system for collecting and displaying statistics  
15 with the email system of the combination of Lytle in view of Trenbeath and Harp. This  
16 combination would have been obvious based on Williams teaching that its type of  
17 display is necessary as the volume of acknowledgment messages becomes large (Col.  
18 2 lines 23-62).

19           Regarding claim 14, the combination of Lytle in view of Trenbeath and Harp  
20 teaches the invention substantially as claimed. See the rejection of claim 1 above.

21           Swenson does not teach the additional limitations of claim 14.

Williams on the other hand teaches a workflow system that collects and displays statistical information regarding each workflow, where the system comprises:

A completion ratio obtaining unit obtaining a completion ratio from completion information indicating that the receivers of the interpersonal message have viewed the interpersonal message, or that business activities related to a content of the interpersonal message are completed (Col. 2 lines 10-15); and

A display unit displaying the completion ratio which is obtained from the completion ratio obtaining unit in a message list (Col. 2 lines 10-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Williams' system for collecting and displaying statistics with the email system of the combination of Lytle in view of Trenbeath and Harp. This combination would have been obvious based on Williams teaching that its type of display is necessary as the volume of acknowledgment messages becomes large (Col. 2 lines 23-62).

***Allowable Subject Matter***

Claims 3, 15, 22, and 26 are allowed.

Claims 7, 9, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including *all of the limitations of the base claim and any intervening claims*.

***Response to Arguments***

Applicant's arguments, see paper 19, filed on September 24, 2003, with respect to claims 1-2, 4-9, 11-14, 16-21, 23-25, and 27-30, they have been fully considered but are not deemed persuasive. The Applicants are arguing in substance the following: (a) the combination of Lytle in view of Trenbeath and Harp does not teach a system wherein the receivers themselves have the ability to enable the display of the receiver state list; (b) the combination of Lytle in view of Trenbeath and Harp does not teach a system wherein the message is selected from a receiver's received message list; (c) the combination of Lytle in view of Trenbeath and Harp does not teach a system where the states relates to the receiver's completion of an activity for which the receiver is responsible; (d) the combination of Lytle in view of Trenbeath and Harp does not teach a system wherein the sender is a manager, the receivers are staff, and the responses indicate whether the staff members' different business activities have been completed; (e) the combination of Lytle in view of Trenbeath and Harp does not teach the additional limitation of claim 29.

As to point (a), Trenbeath teaches that the subscribed messages are replicated/copied to the subscriber client (col. 7 lines 1-5). In the combination, the subscribed message is a message as in Lytle Figure 36, which includes the vote tallies corresponding to the receiver state list. As explained in the rejection, each recipient of the message is also a subscriber client. Since each subscriber client can view the subscribed message, the combination of Lytle in view of Trenbeath and Harp does teach a system wherein the receivers themselves have the ability to enable the display

1 of the receiver state list. Although the Applicants' comments indicate that their invention  
2 is directed to a system wherein a recipient is automatically able to view the receiver  
3 state list with no manual intervention, this limitation does not appear in the claims.

4 As to point (b), Trenbeath teaches that the subscribed messages are  
5 replicated/copied to the subscriber client (col. 7 lines 1-5). A replicated message is  
6 copied to the subscriber client over the network and is therefore a received message.  
7 The system stores the replicated message in a subscription folder. Since the  
8 subscription folder contains replicated messages that are received by the subscriber  
9 client, the subscription folder is a received-message list. Although Trenbeath as cited  
10 does not describe the storing of the subscribed message in the receivers' inbox, it is  
11 clear from the Applicants' comments on page 16 of the response filed on September 24,  
12 2003 that the inbox is merely an exemplary embodiment of a received-message list. So  
13 the Examiner fails to see why a subscription folder storing replicated messages is not a  
14 received message list. In addition, the Applicants' attention is directed to Lytle col. 1  
15 lines 55-63.

16 As to point (d), Lytle teaches a system wherein an office administrator (i.e.,  
17 manager) sends a message to all of the employees (i.e. receivers are staff) asking  
18 whether they will attend the office breakfast (col. 32 lines 7-16). In this situation, the  
19 business activity is for the employee to indicate whether the employee will attend the  
20 office breakfast, which is a business function. The combination of Lytle in view of  
21 Trenbeath and Harp therefore teaches a system wherein the sender is a manager, the

1 receivers are staff, and the responses indicate whether the staff members' different  
2 business activities have been completed

3 As to point (e), the sender of the message in Lytle Figure 36 is directing the  
4 recipients in her department to express a preference for the location of the department's  
5 Christmas party. By expressing a preference, the recipient has completed the business  
6 activity (i.e., Betty Johnson's directive to express a preference). The receiver state list  
7 (Fig. 36 elems. 3605, 3610, 3615) reflects the fact certain recipients have expressed a  
8 preference. The combination of Lytle in view of Trenbeath and Harp therefore teaches  
9 a method wherein the state of the activity reflects a recipient's determination that the  
10 recipient has completed the activity.

11  
12 ***Conclusion***

13 A shortened statutory period for response to this action is set to expire **three**  
14 **months** from the mail date of this letter. Failure to respond within the period for  
15 response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P.  
16 710.02, 710.02(b)).

17  
18 Any inquiry concerning this communication or earlier communications from the  
19 examiner should be directed to Andrew Caldwell, whose telephone number is (703)  
20 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m.  
21 EST.

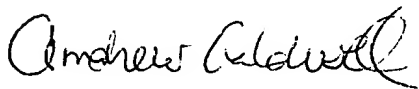
22  
23 If attempts to reach the examiner by phone fail, the examiner's supervisor,  
24 Glenton Burgess, can be reached at (703) 305-4792. Additionally, the fax numbers for  
25 Group 2100 are as follows:

26  
27 Fax Responses: (703) 872-9306  
28



Art Unit: 2151

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.

A handwritten signature in black ink, appearing to read "Andrew Caldwell". The signature is written in a cursive style with a large, stylized initial 'A'.

Andrew Caldwell

703-306-3036

January 3, 2004